



PATENT

ATTORNEY DOCKET NO. 03133.16500.1

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant : FRED C. WEXLER, et al.

Art Unit: 3724

Serial No. : 09/965,834

Examiner: C.F. Dexter

Filed : October 1, 2001

Title : CHANGEABLE COLOR
SHAVING AID

January 27, 2006

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

01/31/2006 SZEWDIE1 00000020 09965834

01 FC:1402 500.00 DP
02 FC:1253 1020.00 DP

BRIEF ON APPEAL AND PETITION FOR EXTENSION OF TIME

Applicants hereby petition under 37 C.F.R. 1.136(a) to extend the time for filing an appeal brief, to and including February 1, 2006. A check in the amount of \$1,020.00 in payment of the petition fee is enclosed, as is a check in the amount of \$500.00 in payment of the appeal brief fee under 37 C.F.R. 41.20(b)(2). Please charge any deficiencies in those fees, or credit any overpayment, to Deposit Account 06-1205.

This is an appeal from the final rejection of Claims 3 and 4 set forth in the Office Action dated March 1, 2005. Notice of Appeal was filed September 1, 2005.

TABLE OF CONTENTS

| | | |
|-------|---|----|
| I. | Real In Party Interest | 1 |
| II. | Related Appeals and Interferences | 1 |
| III. | Status of Claims | 1 |
| IV. | Status of Amendments | 1 |
| V. | Summary of Claimed Subject Matter | 1 |
| VI. | Grounds of Rejection To Be Reviewed On Appeal | 3 |
| VII. | Argument | 4 |
| VIII. | Claims Appendix | 9 |
| IX. | Evidence Appendix | 10 |
| X. | Related Proceedings Appendix | 11 |



BRIEF ON APPEAL

I. Real Party in Interest

The real party in interest is the assignee, The Eveready Battery Company, Inc.

II. Related Appeals and Interferences

There are no related appeals or interferences.

III. Status of Claims

Claims 3 and 4 stand finally rejected and are under appeal. Claims 1 and 2 have been withdrawn from consideration.

IV. Status of Amendments

The claims have not been amended subsequent to the final rejection.

V. Summary of the Claimed Subject Matter

Razor blades have, for many years, been disposable items. Various attempts have been made over the years to devise systems to indicate to the consumer when the used blade should be replaced. All of these prior attempts involved an effort to identify to the user when to discard the blades due to "excessive" blade wear, an extremely difficult and subjective target to ascertain. Most of these attempts used tally devices or the like and relied upon the user's personal action or perception as to when the blade wear was excessive.

Starting in 1977, as disclosed in Booth U.S. Patent No. 4,170,821 and referenced at page 2, line 10, of the present application, in order to provide for smoother shaves and to

increase comfort to the user, shaving aids in the form of comfort strips have been mounted on disposable razor heads. Such strips attached to the razor head are normally comprised of a thermoplastic polymer such as polystyrene and a water soluble lubricating agent such as polyethylene oxide. These strips which have now become commonplace in the industry are particularly beneficial to users with sensitive skin.

Although comfort strips have been around since 1977 and disposable razors even longer, no one until the present inventors conceived of using the shaving aid as an indicator of when to change the razor or razor cartridge. Rather than centering on blade wear (a very elusive objective), the inventors took a totally different approach described in the present specification in the following terms:

Generally, individuals with sensitive skin are most likely to be users of razors containing shaving aids. Consequently, many products which are currently marketed with shaving aids contain materials such as aloe and are directed at the sensitive skin user. However, a drawback of currently available comfort strip-type shaving aids is that the strips gradually degrade and, after a certain number of uses, the shaving aid material contained in the strips is reduced to the point that the strips are not effective for the sensitive skin user. At this point a sensitive skin consumer should replace the razor blade cartridge to ensure the continued availability of shaving aid. However, absent a definite indication, many users do not realize when the cartridge should be replaced and consequently the quality of the shave suffers.

Various attempts have been made to create systems to indicate when the user should change the cartridge. Most of the previous systems require the user to manually interact with the razor by an act such as the turning of a knob or the breaking off of a tab. Such systems are inefficient in that most users are not careful to accurately perform the acts necessary to monitor their razor cartridge usage.

It would, therefore, be desirable to provide a disposable razor cartridge or a disposable razor system with a shaving aid which would automatically indicate to the user that the cartridge containing the shaving aid should be replaced. Such shaving aids would not require manual intervention and thus would be more accurate than presently known systems. (Page 2, line 16 - Page 3, line 13)

In the embodiment of the invention recited in the appealed claims and illustrated in Fig. 5 of the specification, there is provided a shaving aid of a first color (22) coated with a sectional portion of a second color (60) in the form of a stripe that is at least partially water soluble. During shaving, the coated portion (60) wears away through solubility, abrasion or a combination of the two to signal to the user, upon disappearance of the coating, that the shaving aid and its associated razor cartridge should be replaced. (Page 9, lines 13-36) This arrangement, provides a disposable razor cartridge or disposable razor system which automatically indicates to the user that the cartridge containing the shaving aid should be replaced. The sensitive skin user thus has a clear, single point indication as to when replacement of the cartridge is optimal.

VI. Grounds of Rejection To Be Reviewed On Appeal

Whether the subject matter of Claims 3 and 4 are anticipated under 35 U.S.C. 102(b) in view of Doroodian-Shoja Siamak U.S. Patent No. 5,388,331 ("Doroodian").

Claims 3 and 4 stand or fall together.

VII. Argument

In the Final Office Action, Claims 3 and 4 were rejected on the sole ground of anticipation under 35 U.S.C. § 102(a) based upon Doroodian. At the outset, it should be recognized that, as its title states, Doroodian is directed exclusively to a wear indicator for indicating to the user that the blade has been sufficiently worn and requires replacement. By contrast, as noted supra pp. 2-3, the present invention is directed to a shaving aid depletion indicator for indicating to the user, particularly the sensitive skin user, when the shaving aid material in the comfort strip has been depleted to the point that the user, regardless of blade wear, can no longer expect optimal comfort while shaving and should replace the razor cartridge, without regard to the actual wear on the associated blades. Thus, the focus and objective of the present invention and that of Doroodian are totally different.

It is horn book law that, in order for Doroodian to constitute an anticipation of Claims 3 and 4, as contended by the Examiner, each and every limitation in those claims must be present in the cited reference and there “must be no difference between the claimed invention and the reference disclosure...” Scripps Clinic & Res. Foundation v. Genentech, Inc., 927 F.2d 1565, 12 U.S.P.Q. 2d 1157 (Fed. Cir. 1991).

According to the Examiner, Doroodian discloses “a shaving aid strip (e.g. the bottom layer in Figures 3a-3j) that includes a shaving material (e.g. polyethylene oxide see col. 4, lines 33-36) and a coating layer (e.g. the top layer in Figures 3a-3j) wherein a color of the coating layer is different from a color of the shaving aid strip (e.g. see col. 3, lines 39-41) wherein the portion of the shaving aid strip covered by the coating layer is less than the entirety of the top surface of the shaving aid strip (e.g. see Figures 3a, 3f).” The Examiner also asserts that “the shaving aid of Doroodian is fully capable of meeting the limitation that ‘replacement of the

shaving aid strip is indicated when the coating layer disappears due to exposure to water, abrasion or a combination thereof, irrespective of wear on the blade of the razor or razor cartridge.” First, Doroodian does not disclose or even suggest that his wear indicator comprises a “shaving aid strip.” The term “shaving aid” or “shaving aid material” does not appear anywhere in Doroodian’s specification with respect to his alleged invention. Rather the term only appears in the Doroodian patent in reference to the Booth patent which Doroodian dismisses as irrelevant in the following terms:

“However, nothing in Booth suggests that his ‘shaving aid’ serves any function to indicate the relative wear on the blade.” (Col. 1, line 68 - Col. 2, line 2)

Further, the contention of the Examiner regarding the alleged capabilities of the Doroodian wear indicator, as quoted above, is of course totally contrary to the purpose and functions of Doroodian’s disclosure which is concerned exclusively with blade wear indication.

More fundamentally, the Examiner has erroneously assumed that, contrary to the specific teaching in the Doroodian specification, the top layer as shown in front edge view in Fig. 3a and indicated as “unused” corresponds to the top plan view of Fig. 3f. However, according to Doroodian’s specification, “Fig. 3f through 3j depict in top plan view the same indicator means as it is progressively worn away”. Doroodian does not state that the edge view of Fig. 3a corresponds to the top plan view of Fig. 3f or that any of the other Fig. 3 edge views correspond to the side views depicted. The reason that such correspondence is not stated is because it is contrary to Doroodian’s disclosure, as noted elsewhere in the Doroodian specification:

By making the wear indicating means in a color that contrasts with the color of the razor head 14, the relative wear on the strip will be evident because the strip will be

worn away, and the head will become visible. For example, a white strip on a blue razor will gradually be worn away to reveal the blue color underneath. (Col. 3, lines 24-30)

* * *

In this preferred two-layer embodiment, two basic methods for construction are contemplated. In the first method, the two layers are constructed from either the same or different material, but are of contrasting colors. The two layers may have the same longitudinal cross-sections (as, for example, in Fig. 7) or may have different longitudinal cross-sections to create different visual patterns - for example as shown in Fig. 3a, where the upper layer tapers from a thin edge at one end of the strip to a wide edge at the other. As the two layers wear away through abrasion and/or shear stress against the skin and hair, more and more of the contrastingly colored lower layer is disclosed (from left to right, as approximated in Fig. 3f through 3j). Other examples of the two layers having differing cross-sections are illustrated in Figs. 4a and b, 5a and b, and 6a and b wherein the upper layer as shown in Figs. 4a, 5a, and 6a, is abraded away after a selected number of shaves to expose the lower layer (in Figs. 4b, 5b and 6b, respectively). The two layers may be adhered or molded together by known methods.

In another alternative embodiment, the indicator means may consist of a single strip of material, but colored or dyed by known methods so as to create distinguishable zones. As the upper portion or zone of the strip (of one color) is abraded away, the contrastingly colored lower zone becomes visible." (Col. 3, lines 38-64) emphasis added

All the embodiments described and illustrated in Figures 3 through 7 of Doroodian are thus concerned with a 2-layer structure where the top upper layer of one color completely covers the lower layer of a different color.

Doroodian clearly does not support the Examiner's position regarding Figs. 3a, 3f as disclosing a coating layer covering less than the entirety of the top surface of the shaving aid

strip. It is evident when one inspects Figures 3a to 3j that they are, in fact, mere schematic drawings. The boundaries between the upper and lower layers visible in Figures 3f to 3j do not coincide with the boundaries visible in Figures 3a to 3e. Also the angle of the interface between the upper and lower layers varies as between Figures 3a and 3e, for example. For an accurate understanding of Figure 3, the skilled worker would, of necessity, refer to the relevant parts of the specification to understand Doroodian's teachings. Doing this, it would be evident to such skilled worker that Doroodian does not disclose a disposable razor structure or cartridge as defined by Claim 3 and 4 of the present application.

Therefore, the Examiner's rejection under 35 U.S.C. § 102(a) based upon the Doroodian drawings is erroneous since anticipation of a claimed product cannot be predicated on mere conjecture as to the characteristics of a prior art reference. W.L. Gore and Associates, Inc. v. Garlock, Inc., 721 F.2d 1540, 220 U.S.P.Q. 303 (Fed. Cir. 1983).

Another point of distinction between the applicants' invention as set forth in Claims 3 and 4 and the Doroodian patent, resides in the fact that in Doroodian, the blade wear indicator is a progressive indicator wherein the upper coating gradually wears away to reveal more and more of the lower coating. By comparison, stripe 60 of the present application is a single point indicator. Both the stripe of one color and the shaving aid of another color are visible from the outset. There is no progressive wearing away to reveal more and more of the shaving aid. In the Applicants' structure, at a single point in time, when the stripe 60 disappears, the razor is due for replacement.

Thus, the embodiment of Fig. 5 of the present application and the disclosure of Doroodian are directed to different inventions, embody different structures and employ different mechanisms based upon different concepts. Therefore, Claims 3 and 4 are allowable over

Doroodian and not anticipated under 35 U.S.C. § 102(b).

It is respectfully submitted that the final rejection of the claims should be reversed
for the reasons stated.

Respectfully submitted,

Date: 1-27-06

A handwritten signature in black ink, appearing to read "Lawrence F. Scinto", written over a horizontal line.

Lawrence F. Scinto
Reg. No. 18,973

FITZPATRICK, CELLA, HARPER & SCINTO
30 Rockefeller Plaza
New York, NY 10112

Tel.: 212/218-2100
Fax.: 212/218-2200

VIII. Claims Appendix

Claim 3: A shaving aid for a razor or a razor cartridge, comprising:

a shaving aid strip that includes shaving aid material; and

a coating layer covering a portion of a top surface of the shaving aid strip,

wherein a color of the coating layer is different from a color of the shaving aid strip,

wherein the portion of the shaving aid strip covered by the coating layer is less than an entirety of the top surface of the shaving aid strip,

wherein the coating layer is at least partially soluble in water, and

wherein replacement of the shaving aid strip is indicated when the coating layer disappears due to exposure to water, abrasion, or a combination thereof, irrespective of wear on a blade of the razor or the razor cartridge.

Claim 4: A shaving aid according to claim 3, wherein the portion of the shaving aid strip covered by the coating layer is a visible geometric pattern.

IX. Evidence Appendix

None.

X. Related Proceedings Appendix

The European Opposition Division on November 18, 2002, held that the claims of EP-B-773855, the European counterpart to the parent of the present application were impermissibly broadened in violation of Article 123(2) and 123(3) EPC. The Opposition Division also held that the claims were anticipated by the European counterpart to U.S. Patent No. 5,388,331 (Doroodian) by the partially used razor shown in Figs. 6a and 6b of that patent. A copy of this decision was previously made of record as part of an Information Disclosure Statement dated December 18, 2002.

On appeal to the Opposition Division of the EPO by the patent owner, the Opposition Division, on November 22, 2005, dismissed the appeal on the grounds that the claims violated 123(2) EPC as not directly and unambiguously derivable from the application as originally filed. It made no ruling regarding the Doroodian reference. A copy of this decision is annexed hereto.



EPA / EPO / OEB
D - 80298 München
+49 89 / 2399 - 0
TX 523 656 epmu d
Fax +49 89 / 2399 - 4465

Europäisches
Patentamt

European
Patent Office

Office européen
des brevets

Beschwerdekammern

Boards of Appeal

Chambres de recours

Powell, Timothy John
Eric Potter Clarkson,
Park View House,
58 The Ropewalk
Nottingham NG1 5DD
GRANDE BRETAGNE



| | |
|-------------------|--------------------|
| RECORDS | CHECKED |
| 22 NOV 2005 | |
| PARTNER <i>PE</i> | ACTIONED <i>BP</i> |

| |
|------------|
| Datum/Date |
| 15. 11. 05 |

| | |
|---|---|
| Zeichen/Ref./Réf. WARG/P16855EP | Anmeldung Nr./Application No./Demande n°/Patent Nr./Patent No./Brevet n° 95923840.3 - 2302 / 0773855 |
| Anmelder/Applicant/Demandeur/Patentinhaber/Proprietor/Titulaire Warner-Lambert Company LLC | |

| | |
|-----------------------|----------------|
| Appeal Number - Board | T 0047/03-3207 |
|-----------------------|----------------|

Please find enclosed a copy of the decision dated 27. 09. 2005.

The registry:

Domenico Magliano

Phone: (089) 2399-7271



Case Number: T 0047/03 - 3.2.07

DECISION
of the Technical Board of Appeal 3.2.07
of 27 September 2005

Appellant: Warner-Lambert Company LLC
(Proprietor of the patent) 201 Tabor Road
Morris Plains
NJ 07950 (US)

Representative: Powell, Timothy J.
Eric Potter Clarkson
Park View House
58 The Ropewalk
Nottingham MG1 5DD (GB)

Respondent: The Gillette Company
(Opponent) Prudential Tower Building
Boston
MA 02199 (US)

Representative: Renken J.
Hoffmann Eitle
Arabellastr. 4
D-81925 München (DE)

Decision under appeal: Decision of the Opposition Division of the
European Patent Office posted 13 November 2002
revoking European patent No. 0773855 pursuant
to Article 102(1) EPC.

Composition of the Board:

Chairman: H. Meinders
Members: K. Poalas
E. Lachacinski

Summary of Facts and Submissions

- I. The appellant (patent proprietor) lodged an appeal against the decision of the Opposition Division revoking European patent No. 0 773 855.
- II. Opposition had been filed by the opponent against the patent as a whole based on Article 100(a) EPC (lack of novelty and lack of inventive step) and Article 100(b) EPC (insufficiency of disclosure).

The Opposition Division found that claim 1 of the main and the three auxiliary requests violated the requirements of Article 123(3) EPC, that the subject-matter of claim 1 of the main and the three auxiliary requests violated the requirements of Article 123(2) EPC and that it also lacked novelty over the disclosure of document

D3: WO 95 20472 A.

- III. Oral proceedings before the Board of Appeal took place on 27 October 2005.
 - (a) The appellant requested that the decision under appeal be set aside and that the patent be maintained in amended form according to one of the requests filed with the letter of 26 August 2005, or one of those filed during the oral proceedings.
 - (b) The respondent (opponent) requested that the appeal be dismissed and that all requests be rejected as inadmissible.

IV. Independent claims 1 of the main and the six auxiliary requests filed with the letter of 26 August 2005 read as follows:

Main request

A shaving aid (11), for a razor, comprising thermoplastic material and shaving aid material (21) and means for indicating a change in the amount of shaving aid material (21), the means for indicating being in the form of a coating (60), which is water soluble or partially water soluble, disposed in one of more segments on top of at least a portion of the shaving aid, said coating (60) being of a colour different from that of the shaving aid and characterised in that the coating is in the form of a stripe revealing the underlying shaving aid on only two sides of the stripe, said coating (60) being wearable through solubility, abrasion or a combination thereof to provide an indication to the user, upon disappearance of the said coating (60), of a need to replace the razor.

1st Auxiliary Request

A razor head having a cap, a seat, at least one blade and a shaving aid according to claim 1 of the main request.

2nd Auxiliary Request

An unused shaving aid according to claim 1 of the main request.

- 3 -

3rd Auxiliary Request

A shaving aid according to claim 1 of the main request, the shaving aid material being water soluble or partially water soluble.

4th Auxiliary Request

An unused shaving aid according to claim 1 of the main request, wherein the shaving aid material is water soluble or partially water soluble.

5th Auxiliary Request

A razor head having a cap, a seat, at least one blade and an unused shaving aid according to claim 1 of the main request, the shaving aid material being water soluble or partially water soluble.

6th Auxiliary Request

A razor head having a cap, a seat, at least one blade and an unused shaving aid according to claim 1 of the main request without the feature "revealing the underlying shaving aid on only two sides of the stripe", but with the feature that the shaving aid material is water soluble or partially water soluble as well as that the coating is in the form of "a stripe not revealing the underlying shaving aid on fewer than two sides of the stripe".

- V. Independent claims 1 of the main and the six auxiliary requests filed during the oral proceedings differ from the above claims 1 through the insertion of the word

"material" in connection with "shaving aid" into the following phrases:

"a coating (60) ... disposed in one of more segments on top of at least a portion of the shaving aid material",
"said coating (60) being of a colour different from that of the shaving aid material and characterised in that the coating is in the form of a stripe revealing the underlying shaving aid material...".

VI. The appellant argued essentially as follows:

(a) Admissibility of the claims filed with the letter of 26 August 2005

The claims filed with the letter of 26 August 2005 are admissible since they were presented within the time limit given by the Board in the annex to its summons to oral proceedings dated 13 July 2005.

(b) Admissibility of the claims filed during the oral proceedings

The crucial embodiment in the patent in suit is the embodiment of figure 5. Since the new claims 1 of the requests filed during the oral proceedings derive from originally filed claim 9 by adding to the shaving aid according to said claim other features derivable from the embodiment of figure 5, these new claims do not introduce new issues into the debate and should therefore be admitted into the appeal proceedings.

(c) Article 123(2) EPC - claims filed during the oral proceedings

It is obvious to the skilled person from the teaching of the originally filed application as a whole that the shaving aid of the invention comprises thermoplastic material as well as a coating on top of the shaving aid material; this results from claim 1 in conjunction with claim 9 as originally filed, the latter relating to the embodiment of figure 5. In this respect the original claims had priority over the original description for the purpose of providing a basis for amendments. The Booth patent (US 4 170 821 A) mentioned on page 1, lines 15 to 25 of the originally filed application forms the starting point of the present invention by defining the shaving aid as comprising a thermoplastic polymer and a shaving aid material in the form of polyox. Therefore, the embodiment of figure 5 being a further development of such a shaving aid necessarily involves thermoplastic material.

VII. The respondent argued essentially as follows:

(a) Admissibility of the claims filed with the letter of 26 August 2005

These claims involve features that are introduced for the first time in the opposition and appeal proceedings, which have never been discussed before. They are not supported by the application as originally filed.

These claims refer to a coating disposed in one or more segments on top of at least a portion of the shaving aid. Hence, the coating is no longer on the shaving aid

material, as previously claimed. Such an amendment raises entirely new issues, leading to a diverging debate and should not be admitted into the appeal proceedings.

(b) Admissibility of the claims filed during the oral proceedings

A shaving aid comprising a thermoplastic material and a coating on top of the shaving aid material, said coating being in the form of a stripe revealing the underlying shaving aid material on only two sides of the stripe (see claim 1 of the main and the first five auxiliary requests) or said coating being in the form of a stripe not revealing the underlying shaving aid material on fewer than two sides of the stripe (see claim 1 of the sixth auxiliary request) has now been introduced into the debate as late as the oral proceedings before the Board. No explicit or implicit disclosure for such a combination of features can be found in the originally filed application. Therefore, these claims are not prima facie allowable and should therefore not be admitted into the appeal proceedings.

(c) Article 123(2) EPC

The part of the originally filed description directed to the embodiment of figure 5 (see page 11, line 15 to page 12, line 14) and the part of the originally filed description directed to the "summary of the invention" (see page 3, line 19 to page 5, line 21) do not disclose any presence of a thermoplastic material in the shaving aids described therein. On the other hand, originally filed claim 9 dependent on claim 1 is

directed to a shaving aid comprising a thermoplastic material. It is obvious to the skilled person that the shaving aid according to originally filed claim 9 and the shaving aid according to figure 5 are two different embodiments and that combining the shaving aid of the originally filed claim 9 with some of the features of the embodiment of figure 5 contravenes Article 123(2) EPC.

Reasons for the Decision

1. Admissibility of the claims filed with the letter of 26 August 2005

On 26 August 2005, exactly one month prior to the date of the oral proceedings before the Board, the appellant filed a main and six auxiliary requests.

- 1.1 As a general rule, the more complex the issues raised by amendments and the later those amendments are filed, the greater the risk that the remaining time is insufficient to consider them properly. In the case T 1126/97 (not published in the OJ EPO) the deciding board 3.4.1 stated in point 3.1.2 that for late amendments to be admissible the following conditions should be fulfilled:

(i) there should be some justification for the late filing,

(ii) the subject-matter of the new claims should not diverge considerably from the claims already filed, in particular they should not contain subject-matter which has not previously been claimed, and

(iii) the new claims should be clearly allowable in the sense that they do not introduce new objections under the EPC and overcome all outstanding objections.

- 1.2 Furthermore, according to decision T 633/97 (not published in OJ EPO), point 2.2, "once oral proceedings have been arranged in appeal cases, the decision to admit new evidence or requests into the procedure should hinge neither on a fixed time limit for their submission nor on their merit. It should instead be governed primarily by a general interest in the appeal proceedings being conducted in an effective manner, i.e. in dealing with as many of the issues raised by the parties as possible, while still being brought to a close within a reasonable time".
- 1.3 Finally, according to decision T 81/03 (not published in OJ EPO), point 2.4, in a case where new features added to a claim required examination of a solution to an entirely new technical problem, "it is of little importance whether the requests are filed during the oral proceedings or shortly prior to them since in either case the new subject-matter would have to be discussed at the hearing and neither the Board nor the other parties could be expected to deal with it without adjournment of the oral proceedings".

- 1.4 Although concerned with amendments filed during the oral proceedings, decision T 1126/97 sets out criteria which are useful for the present case. In particular, it is pointed out that "the subject-matter of the new claims should not diverge considerably from the claims already filed".

During the entire appeal proceedings the appellant argued that the embodiment according to figure 5 represents the invention of the patent in suit, for which protection was sought in the form of the filed claims. All claims filed by the appellant up to 26 August 2005 refer to a coating disposed in one or more segments on top of at least a portion of the shaving aid material, in accordance with the respective sentence on page 11, lines 16 to 18 of the originally filed application directed to the embodiment of figure 5.

- 1.5 Then, with the letter of 26 August 2005 all claims were amended to a coating disposed in one or more segments on top of at least a portion of the shaving aid, the coating now being no longer necessarily on top of the shaving aid material, as previously claimed.

The appellant, trying to justify this amendment, argued for the first time in the appeal proceedings that the respective sentence in the description - referring to a coating on top of a shaving aid material - is erroneous, since originally filed claim 9 refers to a coating "disposed in one or more segments on top of at least a portion of the shaving aid". Also in the summary of the invention the shaving aid (not the shaving aid material) having one colour is coated with

a sectional portion of another colour, see page 5, lines 7 to 8. Such an obvious error should be corrected.

- 1.6 The Board cannot follow the appellant in this.

The new claims, by referring to a coating on top of the shaving aid instead of on top of the shaving aid material, bring up a new issue which has never been discussed before. This does not lead to a converging debate. To the contrary, this new feature initiates a "diverging debate" in the sense that it requires examination of a new embodiment, namely of the embodiment according to figure 5, in which the coating is not necessarily on top of the shaving aid material as it is stated on page 11, lines 16 to 18, but on top of the shaving aid.

- 1.7 In addition, admitting such an amendment in the claims further initiates an entirely new debate about whether there is an obvious error in the sentence on page 11, lines 16 to 18 of the originally filed description, whether such an error can be corrected under Rule 88 EPC and what the correction should be in order to fulfil the requirements of Article 123(2) EPC. From the above the Board concludes that conditions (ii) and (iii) as set out in T 1126/97 are not fulfilled.

- 1.8 The appellant argued that the respondent in this case had filed comments directed to the new claims in written form and was therefore well prepared to consider these requests.

The Board notes that, regardless of whether the respondent was familiar with all the technical issues, the respondent did not accept that the invention according to these requests was patentable and that the amended features would still require extensive discussion.

- 1.9 For the Board the examination and discussion of this issue would require an adjournment of the oral proceedings which it is not willing to accept. Therefore, it decides pursuant to Article 114(2) EPC not to admit into the appeal proceedings the requests filed with the letter of 26 August 2005.

2. *Admissibility of the set of claims filed during the oral proceedings*

In these claims (which are otherwise the same as the ones filed with letter of 26 August 2005) the issue discussed under point 1 above has been resolved by introducing "material" in connection with the "shaving aid", at the appropriate locations. In this respect the claims concur with the crucial embodiment in the patent in suit, namely the one of figure 5. Therefore, the debate is no longer "diverging" within the meaning of T 1126/97. The remaining amendments can be considered a reply to the preliminary opinion of the Board, given in the annex to the summons to oral proceedings. In that respect the Board considered it expedient to discuss in substance all issues regarding compliance with Article 123(2) EPC at these oral proceedings, including the allowability of the amendment to a stripe revealing the shaving aid material on only two sides or on not fewer than two sides.

Therefore, the Board decides to exercise its discretion according to Article 114(2) EPC and to admit the sets of claims filed during the oral proceedings into the appeal proceedings.

3. *Article 123(2) EPC*

3.1 The appellant argued that all claims of the main and the six auxiliary requests filed during the oral proceedings concern a shaving aid comprising thermoplastic material together with features which according to the originally filed application were present only in the embodiment of figure 5 (cf. the coating on top of the shaving aid material), said coating being in the form of a stripe revealing the underlying shaving aid on only two sides of the stripe (see claim 1 of the main and the first five auxiliary requests) or said coating not revealing the underlying shaving aid material on fewer than two sides of the stripe (see claim 1 of the sixth auxiliary request).

3.2 In order to have the requirements of Article 123(2) EPC fulfilled, it has to be examined if in the originally filed application there is a disclosure for a thermoplastic material forming part of the shaving aid according to figure 5.

The Board agrees with the parties that the originally filed description concerns three independent groups of embodiments, namely a first group with the embodiments according to figure 2 (described on page 7, line 11 to page 10, line 7), the second group with the embodiments according to figures 3 and 4 (described on page 10,

line 9 to page 11, line 13) and the third group with the embodiments according to figure 5 (described on page 11, line 15 to page 12, line 14).

The part of the description directed to the first two groups of embodiments refers to thermoplastic material as being part of the shaving aid in the form of either a mixture with shaving aid material and colouring agents or as a separate layer (see page 9, line 22 to page 10, line 1; page 10, lines 11 to 14; page 11, lines 3 to 8). In contrast to that, the part of the originally filed description directed to the embodiment of figure 5 (see above) and the part of the originally filed description directed to the "summary of the invention" (see page 3, line 19 to page 5, line 21) do not mention any presence of a thermoplastic material in the shaving aids described.

Therefore, the Board finds that the description as originally filed does not provide an unambiguous basis for the presence of thermoplastic material in the shaving aid according to the embodiment of figure 5.

- 3.3 The appellant based its argumentation in the passage on page 1, lines 15 to 25 of the originally filed description mentioning that "In order to provide for smoother shaves and to increase the comfort of the user, ... shaving aids in the form of comfort strips have been mounted on disposable razor heads and in disposable razor systems for many years. For example, U.S. Pat. No. 4,170,821, issued to Booth, discloses a solid water soluble shaving aid incorporated as a strip attached to a disposable razor blade cartridge. Razor heads having such comfort strips are currently marketed with the

shaving aid being mixed with a thermoplastic polymer and have a uniform, unchanging color and texture" as well as the sentence on page 3, lines 19 to 24: "The present invention features a disposable razor cartridge unit or disposable razor system having a shaving aid in the form of a comfort strip mounted on a razor head, wherein the shaving aid changes color over a period of time so that the user knows that the razor head should be replaced".

From these two references it would be evident that the starting point for the present invention is a shaving aid in the form of a comfort strip according to the Booth patent, namely one having a shaving aid material (e.g. polyox) and a thermoplastic matrix. Therefore, each shaving aid further mentioned in the patent in suit is a shaving aid comprising thermoplastic material and as a consequence the embodiment of figure 5 comprises also a thermoplastic material.

- 3.4 The Board cannot follow the appellant's argumentation for the following reasons:

Firstly, the above mentioned passage of the originally filed description refers to the Booth patent as an example of a known shaving aid (see "For example,..."). There is not a single reference in the whole application indicating that the presently discussed shaving aid of figure 5 is built according to the Booth patent, or is "based on known shaving aids".

Even when accepting the appellant's argument that the Booth patent represents an industrial standard in the field of shaving aids, it would have required a proper

specific reference to it so as to conclude that the shaving aid of figure 5 as presently discussed is a further development of the shaving aid according to the Booth patent, which is, however, not there.

Secondly, the Booth patent itself is not limited to shaving aids consisting of shaving aid material and thermoplastic material, it discloses also a shaving aid comprising capsules of micro-encapsulated silicone oil mixed with a cement or binder (see claim 11 and column 4, lines 3 to 7), without any thermoplastic material being present. Therefore, even if the Booth patent would be accepted as the basis for the shaving aid of the patent in suit, it would not be evident that such a shaving aid based on the Booth patent would necessarily comprise shaving aid material and a thermoplastic matrix.

- 3.5 The appellant further argued that the originally filed claim 9, being dependent on claim 1, concerns a shaving aid comprising thermoplastic material, shaving aid material and a coating on top of the shaving aid, the latter being identical to shaving aid material. It is obvious to the skilled person from the whole disclosure of the originally filed application that originally filed claim 9 is related to the embodiment of figure 5. In the claims 1 of the main and all auxiliary requests, a shaving aid built on the basis of originally filed claim 9 was merely supplemented with features derivable from the embodiment of figure 5, thereby remaining a shaving aid comprising thermoplastic material.

- 3.6 The Board is not persuaded by the appellant's arguments for the following reasons:

The shaving aid according to originally filed claim 9, dependent on claim 1, comprises a thermoplastic material, a shaving aid material and a coating disposed on top of at least a portion of the shaving aid.

A shaving aid comprising thermoplastic material and a coating is foreseen only for the shaving aid of the embodiments of figures 3 and 4. However, in these embodiments the coating in the form of a layer 30, 40 covers the thermoplastic material entirely, the latter being further limited to a thermoplastic layer.

In contrast, the shaving aid according to the embodiment of figure 5 as described on page 11, line 15 to page 12, line 14 has a coating disposed upon a section of the surface of the shaving aid material, but there is no mention of any thermoplastic material.

- 3.7 In view of the above it can only be concluded that there is a discrepancy between the subject-matter of claim 9 and the description of the embodiment of figure 5 as filed. It is, however, not unambiguously derivable from the application as filed how this discrepancy is to be resolved: an entire coating of a layer of thermoplastic material (the embodiments of figures 3 and 4 having precedence over claim 9), a partial coating of the shaving aid material with thermoplastic material being present in an unspecified form (claim 9 having precedence over the embodiment of figure 5) or a partial coating of the shaving aid material with no thermoplastic material being present

(the embodiment of figure 5 having precedence over claim 9).

In this respect the Board considers that the claims, description and drawings all have the same ranking (see also T 169/83, OJ 1985, 193, point 3.2) and thus there is no reason to give precedence to the wording of claim 9 as filed, for providing support to the presence of thermoplastic material (in general) in combination with a partial coating of the shaving aid material as specifically described for figure 5.

Therefore, a shaving aid which arises as a combination of originally filed claim 9 with features derivable only from the embodiment described for figure 5 (a partial coating on top of the shaving aid material) is not directly and unambiguously derivable from the application as originally filed.

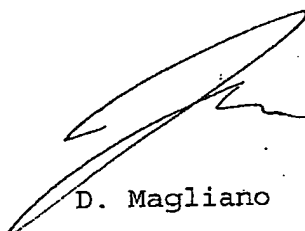
Claim 1 of the main and each of the six auxiliary requests disclosing such a shaving aid, as a result, contravenes the requirements of Article 123(2) EPC. Therefore, these requests are not allowable.

Order

For these reasons it is decided that:

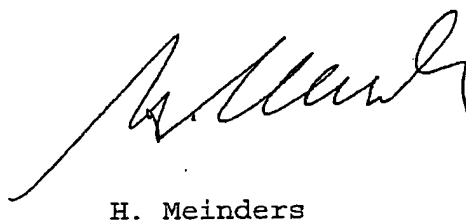
1. The requests filed with the letter of 26 August 2005 are rejected as inadmissible.
2. The appeal is dismissed.

The Registrar:


D. Magliano



The Chairman:


H. Meinders

68.